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| APPLICATION NO.               | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------|-------------|----------------------|---------------------|------------------|
| 10/577,083                    | 12/08/2006  | Claus Permesang      | BE-172PCT           | 4320             |
| 40570                         | 7590        | 05/25/2010           | EXAMINER            |                  |
| FRIEDRICH KUEFFNER            |             |                      | LAUX, JESSICA L     |                  |
| 317 MADISON AVENUE, SUITE 910 |             |                      |                     |                  |
| NEW YORK, NY 10017            |             |                      | ART UNIT            | PAPER NUMBER     |
|                               |             |                      | 3635                |                  |
|                               |             |                      | MAIL DATE           | DELIVERY MODE    |
|                               |             |                      | 05/25/2010          | PAPER            |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/577,083             | PERMESANG, CLAUS    |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | JESSICA LAUX           | 3635                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 22 March 2010.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,4 and 6-22 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,4,6-22 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

This action is in response to the RCE filed 3/22/2010. Claims 1,4,6-22 are currently pending.

### ***Response to Arguments***

Applicant's arguments filed 3/22/2010 have been fully considered but they are not persuasive.

Applicant's arguments that the adhesive layer between the layers (of Fowler, where the layers of Miller et al. in the new rejection are similar to those disclosed by Fowler) is of a small undetermined thickness and is interrupted (or can be) in certain areas and therefore cannot be considered to be the same as the layer of Applicant's claimed invention is not persuasive because Miller et al. clearly discloses that it is common and known to apply adhesive coatings and layers by many techniques, including but not limited to spray foam which, as disclosed by Miller et al. is a very precise and accurate method of applying an adhesive.

Applicant's assertions regarding the indeterminate and inconsistent layer of adhesive appear to be mere conjecture unsupported by fact or evidence. This is in contrast to the disclosure of Miller et al. where it is explicitly taught that adhesive layers can be and are applied in an accurate and precise manner.

Therefore one of ordinary skill in the art would have readily recognized the adhesive intermediate layer of Miller et al. to be the same as or similar to the claimed intermediate layer.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1, 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite a support layer and a layer which is connected to the support layer in lines 2-3 and then later recites an intermediate layer. It is unclear from the claim whether the layer which is connected to the support layer is the same as or different from the intermediate layer. If it is different from the intermediate layer then it is unclear how the intermediate layer, which is disposed on the support layer and the at least one coating element for connecting the two, works with or is arranged with the other layer which is connected to the support layer (i.e. where is the layer that is connected with the support layer disposed in relation to the support layer); if it is the same as the intermediate layer the claim language should be amended to reflect that relationship for clarification.

Claims 4,6 recite the limitation "the joints". There is insufficient antecedent basis for this limitation in the claim. The lack of antecedent basis renders this limitation confusing resulting in an incomplete understanding of the invention as claimed. Therefore the claims will be examined as best understood, however there is confusion and a lack of understanding of the joints and the intermediate layer associated with the joint, particularly regarding the width of the bordering as there has been no previously claimed joint or joint width to which a comparison of half the dimension can be made.

Claims 14, 15 recite the limitation "the layer encompassing the coating element". There is insufficient antecedent basis for this limitation in the claim. It is unclear whether this limitation refers to the intermediate layer, the layer which is connected to the support layer or is a layer separate from the two previously mentioned layers.

In view of the above, the claims will be examined as best understood.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1,4,6-11,13-17,19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller et al (20040031226).**

Claims 1, 4, 6, 10,16, 19-21. Miller et al discloses a flexible building component for forming floor and/or wall coverings comprising a support layer (16) and a layer (the adhesive layer of paragraph 0020) which is connected to the support layer, a floor and/or wall forming layer made of at least one coating element (17-19) as well as elastic joint devices for connecting (20,22) similar building components and/or edge facing elements applied to a floor or a wall, wherein:

the support layer (16) is connected by means of an intermediate layer (the chemical adhesive layer of paragraph 0020) to the at least one coating element (17-19),

wherein the intermediate layer is foamed or sprayed on the support layer and the at least one coating element (paragraphs 0032, 0036, 0038 disclose applying the chemical adhesive glue by spray foam to provide an precise and accurate dispersion of the glue) so as to simultaneously form a bordering integrally connected to the intermediate layer and encircling the building component (where the adhesive is also on the coupling parts as a preglue, element 24), which bordering is of the same material as the intermediate layer (the chemical adhesive as disclosed by Miller et al) wherein the support layer and the coating element are positioned at a distance relative (where they are spaced by the adhesive layer) to each other..

It should be noted that the limitation of "in a molding cavity of a tool" is considered a product-by-process limitation. The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985).

In the instant case the prior product is not necessarily disclosed as being made by the process of being disposed in a tool and spaced by a molding cavity, however the prior art product does have a support layer spaced from a coating element by an intermediate layer that is spray foamed on. Therefore the prior art product is the same as Applicant's claimed invention and the process by which it was made, whether different or not, is immaterial to patentability.

Claim 7. The building component according to claim 1, wherein the intermediate layer is made of an elastic and/or water-resistant material (paragraphs 0040-0048).

Claim 8. The building component according to claim 1, wherein the support layer is made of recycling material (paragraph 0021).

Claim 9. The building component according to claim 1, wherein the coating element is made of ceramic, stoneware, natural stone, glass, plastic, metal and/or wood (paragraphs 0022-0024).

Claim 11. The building component according to claim 1, wherein the devices for connecting are connector devices (20, 22) for tongue-and-groove joints.

Claim 13. A building component according to claim 10, wherein engaging connector devices are provided (as seen in figures 2-3, particularly at elements 21,23).

Claim 14 (as best understood). The building component according to claim 11, wherein the groove is formed between the support layer and the layer encompassing the coating element (as seen in the figures).

Claim 15 (as best understood). The building component according to claim 10, wherein the edges of the support layer and of the layer encompassing the coating element are arranged offset relative to each other, parallel to the plane of the support layer (as seen in figure 2).

Claim 17. The building component according to claim 1, wherein the support layer has a surface profile (as seen in the figures).

Claim 22. The building component according to claim 1, wherein the building component is curved as a whole and/or exhibits a curved surface (at 23).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al (20040031226) in view of Miller et al (20030208980).**

Claim 12. Miller et al. ('226) discloses the building component according to claim 11, where a tongue is formed opposite a groove, however Miller et al ('226) does not disclose that a tongue and groove are formed at two sides respectively. Rather Miller et al. ('226) discloses that a tongue and groove are formed at one side.

Miller et al. ('980) discloses a building component having layers and a tongue formed opposite a groove, where the groove is at two adjacent perpendicular sides and the tongues are opposite the grooves (figure1).

At the time the invention was made it would have been obvious to one having ordinary skill in the art to modify the component of '226 to have two perpendicular sides with a groove and the opposite sides with a tongue to improve the connection between adjacent placed building components by having a connection on all sides of the component.

**Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al (20040031226) in view of Milborn (2548036).**

Claim 18. Miller et al. discloses the building component according to claim 1, but does not disclose pipes for a heating and/or cooling, heating conductors and/or sensors are embedded in the building component in the support layer.

Milborn discloses a panel for use in flooring having layers and pipes disposed in a support layer for heating a floor made of the panels (see figures; disclosure).

At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the panel of Miller et al. to have the pipes as disclosed by Milborn to incorporate heating/cooling into the building component to provide efficient and space-saving thermal elements to a building.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA LAUX whose telephone number is (571)272-8228. The examiner can normally be reached on Monday thru Thursday, 9:00am to 5:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jessica Laux/  
Examiner, Art Unit 3635